

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

060258-0282898

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on _____

Signature _____

Typed or printed name _____

Application Number

09/870,277

Filed

May 30, 2001

First Named Inventor

PEDERSEN, et al.

Art Unit

3691

Examiner

CAMPBELL, Kellie L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Larry J. Hume/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Larry J. Hume

Typed or printed name

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Registration number 44,163

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☐ attorney or agent acting under 37 CFR 1.34.

November 23, 2009

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: PEDERSEN,
ET AL

Confirmation Number: 7410

Application No.: 09/870,277

Group Art Unit: 3691

Filed: May 30, 2001

Examiner: CAMPBELL, Kellie L.

Title: DEPOSITING METHOD AND ARRANGEMENT

ARGUMENTS SUBMITTED WITH PRE-APPEAL BRIEF CONFERENCE REQUEST

MS AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action dated July 22, 2009, and concurrent with the "Notice of Appeal", "Pre-Appeal Brief Conference Request", Amendment after Final Rejection, and Petition for 1-Month Extension of time, all filed concurrently filed herewith, Appellant submits the following arguments for consideration by the Appeal Conferees. Claims 2-5, 8, 9, 11-14, 17 and 20-22 are pending, and claims 2, 3, 8, 12, 14 and 20 are independent.

I. REJECTIONS TO BE REVIEWED UPON APPEAL

- A. ***Indefiniteness rejections*** of claims 2 and 22 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.¹
- B. ***Unpatentability rejection*** of claims 3-14, 17, and 20 under 35 U.S.C. §103(a), as allegedly being unpatentable over Fougnyes, et al. (US 5,854,975) in view of Segal, et al (US 6,167,251).²
- C. ***Unpatentability rejection*** of claims 21 and 22 under 35 U.S.C. §103(a), as allegedly being unpatentable over Fougnyes in view of Segal and in further view of Joyce (US 6,320,947 B1).

Due to page limits of this Request, the Arguments presented herein are directed only to the unpatentability rejections of independent claims 3, 8, and 12 (claim 2 is allowable), i.e., Section I.B, above. Similar arguments pertain to the rejection of each of the remaining independent claims 14 and 20, and the remaining dependent claim, i.e., claim 17, and the Appeal Conferees are asked to extend the arguments presented to the claims that are not explicitly addressed herein.

II. ARGUMENTS – INDEPENDENT CLAIMS 3, 8, 12, 14 AND 20

- A. **Appellants submit that the indefiniteness rejection of claims 2 and 22 has been rendered moot in view of the concurrently-filed Amendment after Final Rejection.**

¹ This rejection will be addressed on Appeal only if the Examiner refuses entry of the clarifying amendment to claims 2 and 22 made in the Amendment after Final Rejection filed concurrently herewith.

² Dependent claim 7 should not be included in this rejection, as it depends from claim 2, which would be allowable if the indefiniteness rejection is overcome, thus making claim 7 conditionally allowable as well.

In the event that the Examiner denies entry of the accompanying Amendment after Final Rejection, Appellants submit that the conditional recitation in the form of "if" *<a specific condition occurs, then an action is taken>*, is not indefinite. A person of ordinary skill in the art would understand this common construct in claim drafting, in particular, with respect to claims directed to computer-implemented methods as in the application on Appeal.

B. Appellants submit that the Examiner has not made a prima facie case for unpatentability of claims 3-14, 17, and 20 over Fougnyes in view of Segal.

1. Specific Deficiencies of the References with Respect to the Claims

Appellants submit that at least the *bold, italicized* portions of the independent claims identified below are not taught or suggested by the combination of references set forth by the Examiner. Since all the independent claims on Appeal recite a solution in which a way to update the credit is selected among at least two different ways based upon on a voucher type comparison between the new voucher and the last-used voucher, Appellants submit that the independent claims are patentable over the art of record.

Each of the independent claim on Appeal is submitted as differing from allowable claim 2 only in the "second way" to update the account balance. *Appellants submit that the art of record is clearly deficient with respect to showing any "second way" to update the balance.*

a. Independent Claim 3

Neither Fougnyes nor Segal, alone or in combination, disclose, teach, or suggest a computer-implemented method for calculating a subscriber's account balance *in a telecommunications system where at least two different types of vouchers having the same type of a credit value can be used for making deposits in the account, which vouchers may be bought, the types of the vouchers differing from each other at least so that a certain amount of a calling time has different prices in different types of the vouchers*, wherein the method includes, *inter alia*, "defining, to a memory, at least two different ways of updating the account balance for the same type of a credit value, wherein the first way to update comprises calculating, by a processor coupled to the memory, the account balance by adding a value of a new voucher to the credit in the account, and the second way to update comprises determining a factor, other than one, multiplying the credit in the account with the factor, adding the result of said multiplication to the credit value of the new voucher, and setting the account balance to be the result of said addition; maintaining information in a database separate from account balance information, said information indicating the type of a last used voucher of the subscriber; receiving a deposit identifying a new voucher which the subscriber is going to use to update his/her credit; determining, by the processor, the type of the new voucher; *determining, by the processor, the type of the last used voucher of the subscriber*; comparing, by the processor, the type of the new voucher with the type of the last used voucher of the

subscriber; **and if said vouchers are of the same type, using the processor to calculate the first way to update the account balance; and; if said vouchers are of a different type of vouchers having the same type of a credit value, using the processor to calculate the second way to update the account balance,**" as recited in independent claim 3 (*emphasis added*).

b. Independent Claim 8

Furthermore, neither Fougnyes nor Segal, alone or in combination, disclose, teach, or suggest a telecommunications system in which a subscriber can pre-pay for the subscriber's calls by making deposits in the subscriber's account **using at least two different types of vouchers having the same type of a credit value, wherein said vouchers may be bought, the types of the vouchers differing from each other at least so that a certain amount of a calling time has different prices in different types of the vouchers,** wherein the telecommunications system includes, *inter alia*, "a database configured to contain voucher-specific information and subscriber-specific information; and a network element connectable to the database and comprising a memory, a processor, and an interface for user interaction, **the network element being configured to: obtain, from the database, and in response to the subscriber making a deposit, voucher-specific information and a subscriber's subscriber-specific information; determine, by using the obtained information, a type of a last used voucher of the subscriber and the type of a new voucher which the subscriber is going to use to update the subscriber's account balance; compare the type of the last used voucher with the type of the new voucher; apply a first method stored in the memory and executed by the processor to update the account balance in a first way if the last used voucher and the new voucher are the same type, wherein the first way comprises calculating the account balance by adding a credit value of a new voucher to the credit in the account; detect a change of voucher if the last used voucher and the new voucher are of different type of vouchers having the same type of credit value; and in response to said detection, update the account balance in a second way different from the first way, wherein the second way comprises calculating the account balance by setting the account balance to be the credit value of the new voucher,**" as recited in independent claim 8 (*emphasis added*).

c. Independent Claim 12

Still further, neither Fougnyes nor Segal, alone or in combination, disclose, teach, or suggest a network element for a telecommunications system where a subscriber of the system can pre-pay for the subscriber's calls by making deposits in the subscriber's account **using at least two different types of vouchers having the same type of a credit value, which vouchers may be bought, the types of the vouchers differing from each other at least so that a certain amount of a calling time has different prices in different types of the vouchers,** wherein the network element includes, *inter alia*, "a memory in which the account balance, and information indicating, subscriber-specifically, a type of a voucher last used by the

subscriber are maintained, *said information relating to the type of voucher last used being maintained separate from the account balance; a processor coupled to the memory and configured to: determine the type of a voucher last used by the subscriber; determine the type of the new voucher which the subscriber is going to use to update the subscriber's account balance; compare the type of the voucher last used by the subscriber with the type of the new voucher, calculate the account balance by adding a credit value of a new voucher to the credit in the account if said vouchers are of the same type, and calculate the account balance by setting the account balance to be the credit value of the new voucher if said vouchers are of a different type of vouchers having the same type of a credit value,*" as recited in independent claim 12 (*emphasis added*).

2. Discussion of the Unpatentability Rejections and the Cited Art

By way of background, various embodiments and aspects of Appellants' disclosed and claimed invention are directed to a method, arrangement, and network element that make the change of subscription type easy for telecommunications system subscribers using prepaid subscriptions. Information indicating the types of a last-used voucher type and a new voucher type is maintained and used to detect a change of subscription type, and to select the proper way to update the credit to the subscriber's account.

In the Office Action of December 13, 2007, *i.e.*, *three* Office Actions ago, the previous Examiner cited Fougnyes and Segal in the unpatentability of the independent claims. These rejections were previously overcome, resulting only in §101 and §112, ¶2 rejections in the Office Action previous to the current Final Office Action.

Notwithstanding the lack of compact prosecution due to the imposition of previously overcome references, *Fougnyes fails to teach two different ways of updating the credit, the ways differing such that if the same value is used, a first way to update will give a first amount of updated credit, and a second way to update will give a second amount of updated credit, wherein the second amount is different than the first amount.* Thus, Fougnyes fails to teach Applicants' claimed different ways of updating. Further, *the credit balance of Fougnyes is incapable of indicating the type of a voucher among voucher types having the same type of values* (and thereby providing the same type of balance credits). Thus *Fougnyes also fails to disclose Applicants' variously claimed maintenance of information, separate from credit information, that indicates the type of a last used voucher of the subscriber.*

The Examiner admits that Fougnyes fails to teach the voucher types have the same type of value, and asserts that Segal makes up for this admitted deficiency by teaching prepaid different airtime cartridges which can differ based on time allotted. The Examiner goes on to assert that it would have been obvious to person of ordinary skill in the art to modify the voucher types of Fougnyes (airtime and monthly) to include that vouchers

are, instead, of the same currency and updated differently based on price per amount of time because it also provides for updating a balance based on the plurality of available types of pre-paid phone cards available.

Notwithstanding whether or not this characterization of Segal is correct, Appellants submit that *the combination of Fougnyes and Segal would simply teach a person of ordinary skill in the art that different types of vouchers having the same type of a credit value can be bought, but only that the type of voucher with which an account is updated is taken into account when the account balance is updated.* Thus, the suggested combination of Fougnyes with Segal at least fails to disclose various features of the independent claims as discussed in detail above with specificity to the claims on Appeal, and which can be seen to generally relate to having different first and second updating methods, determining a type of last voucher used, and comparing the type of the new voucher and the last used voucher when updating the account balance, as discussed above in further detail.

C. Appellants submit that the Examiner has not made a prima facie case for unpatentability of claims 21-22 over Fougnyes and Segal in view of Joyce.

Appellants submit that at least the *bold, italicized* portions of independent claim 12, identified above, are not taught or suggested by the combination of references set forth by the Examiner in this rejection, such that the rejection should be reversed.

III. CONCLUSION

Accordingly, since the applied art does not teach or suggest all the claimed limitations, reversal of the Examiner by the Appeal Conferees and allowance of independent claims 3, 8, 12, 14 and 20 are respectfully requested. In addition, dependent claims 4-6, 9-11, 13, 17, 21, and 22 variously and ultimately depend from allowable independent claims 3, 8, 12, 14, and 20, and are submitted as being allowable at least on that basis, without further recourse to the patentable features recited therein.

Date: November 23, 2009

Respectfully submitted,

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